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**Datasheet for the decision
of 9 January 2019**

Case Number: T 1860/13 - 3.4.01

Application Number: 02805222.3

Publication Number: 1456810

IPC: G06K19/02, B42D15/10

Language of the proceedings: EN

Title of invention:

MULTIPLE IMAGE SECURITY FEATURES FOR IDENTIFICATION DOCUMENTS
AND METHODS OF MAKING SAME

Patent Proprietor:

L-1 SECURE CREDENTIALING, INC.

Opponents:

Bundesdruckerei GmbH
Securency International Pty Ltd
GIESECKE & DEVRIENT GmbH

Headword:

Multiple image security features / L-1 Secure Credentialing

Relevant legal provisions:

EPC Art. 123(2), 108
EPC R. 99(2)

Keyword:

Admissibility of appeal - (yes) - appeal sufficiently substantiated (yes)

Novelty - auxiliary request (yes)

Inventive step - auxiliary request (yes)

Decisions cited:

T 2201/10

Catchword:

With the withdrawal of their oppositions, the opponents renounced to their positions as parties to the proceedings and accordingly to any active role in them. The submissions filed by opponent III, following the filing of the statement of grounds by the appellant/patentee, are therefore regarded as observations made by a third party under Article 115 EPC. The request filed by former opponent III is without effect.



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Case Number: T 1860/13 - 3.4.01

D E C I S I O N
of Technical Board of Appeal 3.4.01
of 9 January 2019

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Decision under appeal: **Decision of the Opposition Division of the
European Patent Office posted on 1 July 2013
revoking European patent No. 1456810 pursuant to
Article 101(3) (b) EPC.**

Composition of the Board:

Chairman P. Scriven
Members: P. Fontenay
 J. Geschwind

Summary of Facts and Submissions

I. The appeal is against the decision of the Opposition Division to revoke European patent EP-B-1 456 810.

II. Three oppositions had initially been filed against the patent on the grounds of Articles 100(a) EPC for lack of novelty and lack of inventive step and on the grounds of Article 100(b) and 100(c) EPC.

All three oppositions were later withdrawn.

III. The Opposition Division, of its own motion, decided to continue the examination of the oppositions.

IV. The Opposition Division held that the subject-matter of the patent as granted extends beyond the content of the application as filed (Article 100(c) EPC).

Concretely, the Opposition Division considered that the step of embossing a lens profile onto a selected portion of the transparent film at a first location wherein the first location substantially coincides with the location of the information provided on the information bearing layer, in granted claim 1, was not supported by the original disclosure. In particular, the terms "substantially coincides" did not derive from the original disclosure contrary to Article 123(2) EPC.

The Opposition Division further held that the subject-matter of granted independent claims 1 and 8 was not new in view of document:

D6: DE-A-36 34 865.

- V. The patentee filed an appeal against the decision and requested that it be set aside and that the patent be maintained as granted.

As an alternative, maintenance of the patent on the basis of a set of claims according to an auxiliary request, filed with the statement of grounds, was requested.

Oral proceedings were requested "in case that the Board of Appeal considers the claims of the auxiliary request to not comply with the requirements of the EPC".

- VI. With regard to the main request, the appellant argued that the objection of added subject-matter was not justified. Comments were also provided as to why various objections raised earlier in the course of the opposition proceedings regarding insufficiency of disclosure under Article 83 EPC were not convincing.
- VII. With regard to the auxiliary request, the appellant underlined that the feature added to independent claims 1 and 8 regarding the materials used for the transparent film material conferred novelty over the available prior art. The appellant further put forward that the selection of these materials was not obvious when starting from document D1 (US-A-4 869 946), which it took to represent the closest prior art.

- VIII. A former opponent (Opponent III) filed comments regarding the appellant's auxiliary request and requested that the appeal be dismissed.
- IX. A summons to attend oral proceedings were issued. The appellant's request for oral proceedings was later withdrawn and the oral proceedings accordingly cancelled.
- X. The requests filed by the appellant with the statement of grounds constitute the appellant's final requests.
- XI. Claim 1 of the appellant's main request, i.e. of the patent as granted, reads:

A method for making a secure identification document with multiple images comprising: providing information on an information-bearing layer, the information constructed and arranged to be capable of providing multiple images when the information is viewed at different predetermined angles through an appropriate lens; covering the information with a layer of substantially transparent film material; embossing a lens profile onto a selected portion of the substantially transparent film material at a first location, wherein the selected portion of the substantially transparent film material comprises an area that is less than the entire area of substantially transparent film material and wherein the first location substantially

coincides with the location of the information provided on the information-bearing layer, the lens profile forms a lens on a portion of the substantially transparent film material, and the lens enables the information viewed through the lens to display multiple images when the information is viewed at different predetermined angles.

XII. Claim 8 of the appellant's main request, i.e. of the patent as granted, reads:

*An information bearing document comprising:
a core layer;
an interlaced image formed on the core layer, the interlaced image comprising first and second images, the interlaced image constructed and arranged to permit the first and second images to be visible at a first and second respective predetermined angle when the first and second images are viewed through a predetermined lenticular lens; and
a substantially transparent layer operably coupled to the core layer, the substantially transparent layer comprising at least a first portion with no lenticular lens formed thereon and at least a second portion having a lenticular lens formed thereon, the lenticular lens being located at a predetermined location selected to overlay at least a portion of the interlaced image when the substantially transparent layer is coupled to the core layer, and wherein the lenticular lens is constructed and arranged*

be [sic] operable with the interlaced image to enable the first and second images in the interlaced image to be viewable through the lenticular lens at two different respective angles.

XIII. The auxiliary request consists of 13 claims. Claim 1 differs from claim 1 of the main request in that it incorporates, at the end, the additional feature: *"wherein the substantially transparent film material is amorphous polyethylene or a polyester which is a reaction product of the polymerization of ethylene glycols with polycarboxylic acids"*.

A corresponding limitation was introduced at the end of independent claim 8. The added feature reads: *"wherein the substantially transparent layer is made of amorphous polyethylene or of a polyester which is a reaction product of the polymerization of ethylene glycols with polycarboxylic acids"*.

Reasons for the Decision

1. Requests filed by former opponent

The three oppositions filed by the opponents were later withdrawn. With the withdrawal of their oppositions, the opponents renounced to their positions as parties to the proceedings and, accordingly, any active role in them. The fact that the Opposition Division continued

ex officio with the examination of the oppositions does not affect this.

The submissions filed by opponent III, following the filing of the statement of grounds by the appellant/patentee, are, therefore, regarded as observations made by a third party under Article 115 EPC. The request filed by former opponent III is without effect.

2. *Admissibility of the appeal*

The Opposition Division based its decision to revoke the patent on two grounds, namely, on the ground that the granted patent contained subject-matter extending beyond the content of the application as filed and on the ground that the subject-matters of independent claims 1 and 8, as granted, were not new.

The statement of grounds does not, however, take issue with the objection of lack of novelty, insofar as the main request (the subject of the impugned decision) is concerned. With regard to this request, the appellant provides only arguments as to why the objection of added subject-matter under Article 123(2) was not justified, and why former objections regarding insufficiency of disclosure under Article 83 EPC were not convincing. In contrast, the section dedicated to the auxiliary request elaborates on the significance of the added features with regard to the requirements of novelty and inventive step, but is silent on the issue of added subject-matter.

Rule 99(2) EPC reads: "*In the statement of grounds of appeal the appellants shall indicate the reasons for setting aside the decision impugned, or the extent to*

which it is to be amended and the facts and evidence on which the appeal is based".

Although the section of the grounds of appeal dedicated to the main request lacks the required analysis as to why the finding of lack of novelty is not justified, the Board holds that the conditions of Rule 99(2) EPC are nevertheless met. In the Board's judgment, the statement of grounds, considered in its entirety, together with the auxiliary request, provides sufficient information for the Board to work out why the impugned decision should be set aside.

The section of the grounds dedicated to the auxiliary request elaborates on why the subject-matter of the auxiliary request is new with regard to the prior art. Although this section of the grounds of appeal does not address the issue of added subject-matter under Article 123(2) EPC, the reader would readily recognise that the analysis relied upon by the appellant with regard to the main request applies *mutatis mutandis*. The relevant wording is not different in this request.

In conclusion, the statement of grounds includes, as a whole, the reasons for setting aside the impugned decision as well as the extent to which it is to be amended.

The appeal is thus admissible (Article 106 EPC, Rule 99 EPC).

3. *Admissibility of the main request*

As mentioned above, the appellant fails to indicate, in the statement of grounds, the reasons why the findings

of the Opposition Division with regard to lack of novelty of the subject-matter of claims 1 and 8 of the patent as granted (main request) are not valid for this request.

The section of the grounds of appeal dedicated to the auxiliary request elaborates on the relevance of the added feature to novelty and inventive step. These comments do not apply to the main request.

The statement of grounds, as a whole, does not even establish whether the appellant disagrees with the findings of the Opposition Division with regard to the lack of novelty of the granted subject-matter.

It is not up to the Board, when deciding on the admissibility of a request, to search for reasons that the appellant has failed to provide. Under the present circumstances, none of the arguments provided in the statement of grounds, considered as a whole, tells the Board why the decision with regard to novelty of the main request should be set aside.

Consequently, the main request is not admitted into the appeal proceedings.

4. *Admissibility of the auxiliary request*

The positive assessment made above with regard to the admissibility of the appeal results from the fact that one of the two requests filed by the appellant was considered to meet the requirements of Rule 99(2) EPC. Concretely, the Board considers that the conditions of Rule 99(2) EPC are met by the auxiliary request, in

view of the appellant's submissions in the statement of grounds considered in its entirety.

In conclusion, the statement of grounds, considered as a whole, provides sufficient information as to why, in the appellant's view, the two grounds relied upon to revoke the patent do not apply to the auxiliary request.

The auxiliary request is thus admitted into the appeal proceedings.

5. *Auxiliary request - Allowability*

5.1 *Added subject-matter - Article 123(2) EPC*

The Opposition Division held that the terms "substantially coincides" in claim 1 of the granted patent define subject-matter that does not result from the content of the application as filed. The same wording is also present in claim 1 of the auxiliary request.

In the statement of grounds, the appellant submitted that the terms objected to derive directly and unambiguously from various passages in the original disclosure. The appellant's submissions focus on the fact that the disclosure indeed supports the feature of two areas "coinciding" and are persuasive, in this respect. The original disclosure contains sufficient evidence for the fact that the first location coincides with the location of the information provided on the information bearing layer (cf. Figures 3, 5, 6, and page 6, line 35 - page 7, line 9 of the published application). This feature also appears to result

directly from the very purpose of the claimed invention according to which the information provided on the information bearing layer should allow various individual images to be viewed from different angles, while limiting the presence of the lens profile to a selected portion of the transparent film material.

Although the Opposition Division did not elaborate on the content of the objection raised, it may however be assumed that it, in effect, objected to the use of the adverb "substantially" in combination with the term "coincide".

The question to be answered is thus whether "substantially coincides" actually differs from "coincides", in the context of the present invention. In other words, does the use of the adverb indeed convey information that extends beyond what was originally disclosed?

It is certainly true that the position of each of the multiple lenticules must precisely correspond to the position of each corresponding pair of interlaced image stripes on the information bearing layer. A shift of the lens profile in terms of rows of pixels would undoubtedly affect the quality and content of the images to be viewed from various angles. It follows that the location of each lenticule (116a - 116n) must precisely correspond to the location of a pair of interlaced image stripes. The feature objected to does not, however, appear to refer to this particular aspect of the invention regarding the required alignment of the lenticule and corresponding pair of interlaced images but, more generally, to the location of the embossed area, as a whole, in relation to the location of the information on the information bearing layer.

With regard to the problem addressed by the invention (cf. page 6, lines 5-16 of the published application), the precise location of the whole embossed area is not essential as long as it somehow coincides with the information area of the information bearing layer. Under the circumstances, the embossed area may be larger, or even slightly smaller, than the location of the information on the information bearing layer without impeding the interlaced image from being viewable through the lenticular lens from different respective angles.

As a consequence, the subject-matter of claim 1 of the auxiliary request derives directly and unambiguously from the original application as filed. The requirements of Article 123(2) EPC are met.

5.2 *Novelty (Article 54 EPC)*

5.2.1 Document D1, referred to as D1/E3/P1 in the impugned decision, corresponds to the item of prior art identified in the paragraph bridging pages 5 and 6 of the published application, corresponding to paragraph [0022] of the patent specification. Independently of the fact that D1 is silent as to the material used to manufacture the lens layer, the method of claim 1 according to the auxiliary request differs from the method disclosed in D1 in that the selected portion to be embossed comprises an area that is less than the entire area of transparent film material.

Similarly, the subject-matter of claim 8 according to the auxiliary request differs from the information bearing document disclosed in D1 in that the

transparent layer comprises at least a first portion with no lenticular lens formed thereon.

The subject-matters of claims 1 and 8 according to the auxiliary request is, therefore, new with regard to D1.

- 5.2.2 Document D6 was referred to by the Opposition Division as evidence that the method of claim 1 and the information bearing document of claim 8 of the granted patent were not new in the sense of Article 54 EPC. This objection was initially put forward by Opponent I.

Relying on the formulation "A method for making a secure identification document with multiple images **comprising: ...**", Opponent I submitted that granted method claim 1 did not contain any limitation as to the sequence of the steps actually recited in the claim. This position was later endorsed by the Opposition Division. This assessment is not tenable.

While it is certainly the duty of a board to consider the arguments provided in support of an admissible request, it may be argued that it is also, to a certain extent, its duty, when deciding on the allowability of a request, critically to review aspects relevant for the decision to be taken that have neither explicitly nor implicitly been challenged. This is the position adopted by the Board in present case with regard to the distinguishing features resulting from the sequence of steps recited in claim 1: an aspect that had not been addressed by the appellant in the statement of grounds.

A sequence of operations implicitly derives from the recited steps in claim 1, at least to a certain extent. In particular, the step of "covering the information with a layer of substantially transparent film

material" requires the presence of said information and thus necessarily follows the step of "providing information on an information bearing layer".

Similarly, the step of "embossing a lens profile onto a selected portion of the transparent film material at a first location" combined with the further indication that "the first location substantially coincides with the location of the information provided on the information bearing layer" implies that the step of embossing follows the step of covering the information.

The method of D6 does not reproduce the sequence of claim 1 since, in D6, the information is provided on the information bearing layer after that said layer has been covered with a transparent film and embossed in order to provide the required lens profile. It is stressed, in this respect, that in the context of D6 the reproduction of the information by means of a laser requires the presence of the lens profile in order for said information to be reproduced at the adequate location.

The feature, in claim 8, of "the lenticular lens being located at a predetermined location selected to overlay at least a portion of the interlaced image when the substantially transparent layer is coupled to the core layer" defines a feature of the claimed information bearing document by reference to a step of its manufacturing process. Concretely, this feature implies that the lenticular lens is located at a predetermined location selected to overlay at least a portion of the interlaced image **when** the substantially transparent layer is coupled to the core layer. This formulation is relevant to the novelty of the claimed invention only insofar as it leads to structural differences between the claimed subject-matter and the prior art.

This appears to be the case under the present circumstances, since the step described in D6 of engraving an image through the lenticular lenses indeed affects the integrity of both the lens itself and the information bearing layer as expounded in length in D6 (cf. D6, col. 12, lines 50-61; col. 13, lines 27-34; col. 15, line 24 - column 16, line 59; Figures 4, 5). The feature of claim 8 reproduced above, however, implies that the interlaced image be present on the information bearing layer before it is coupled to the transparent film. It follows that the information bearing layer according to claim 8 differs from the information bearing layer known from D6.

The subject-matter of claims 1 and 8 according to the auxiliary request is thus new with regard to document D6.

5.2.3 None of the other available documents appear to disclose the features of claims 1 or claim 8 of the auxiliary request in combination.

5.2.4 Claims 1 and 8 of the auxiliary request define new subject-matter (Articles 52, 54 EPC).

5.3 Inventive step (Article 56 EPC)

Both documents D1 and D6 could be considered, *a priori*, as suitable starting points when assessing inventive step.

5.3.1 As underlined above, the wording of claim 1 of the auxiliary request implies that the recited steps are performed according to a particular sequence. The step of covering the information with a layer of

substantially transparent film material implies that said information has been previously provided on the information bearing layer.

In contrast, the method of D6 requires the transparent film material being previously provided on the layer intended to carry the information and embossed before the transfer of information can take place. This directly results from the fact that, according to D6, said information is obtained by means of a laser which needs to interact with the lens profile in order to reproduce the interleaved portions of the various images from appropriate viewing positions.

The claimed invention addresses, primarily, the problems identified by the appellant on page 6, lines 5-15 of the published application. The subject-matter of independent claims 1 and 8 permits the avoidance of using the lenticular lens to create the stripes of interlaced images, which requires a high degree of precision to produce the information on the information bearing layer.

The use of a laser in D6 constitutes an essential aspect of the invention disclosed in this item of prior art. It solves the problem resulting from the need to have the lens profile located at a very precise location with regard to the location of the interleaved images on the information bearing layer. In other terms, the method of D6 guarantees that each pair of the interlaced image will be adequately registered with regard to each lenticule, so that two different images will be viewable from different respective angles. This is the essence of the invention according to D6. There is no incentive for the skilled person to depart from such an approach which would require renouncing to a

feature considered essential in the context of said prior art (cf. T 2201/10, point 5.1.3).

A similar finding applies with regard to independent claim 8 considering that the claim's wording implies that the claimed product is obtained according to a method which differs from the method of D6 where the selection of the location of the lenticular lens is made before the interlaced image is reproduced on the information bearing layer.

- 5.3.2 Document D1 corresponds to the prior art acknowledged by the applicant in the original application. In the appellant's view, D1 illustrates the closest prior art.

In the method of D1, the image including the pairs of interlaced stripes are transferred on the information bearing layer by photographic means. The image is laid down onto a photographic emulsion by means of the lenticular system (cf. D1, column 3, lines 8-20) thus requiring the lenticular system to be integrated with the information bearing layer before the image on said layer is actually formed.

The method of claim 1 differs from the method of D1 by:

- the selection of the material to be used for the transparent layer as emphasised by the appellant, but also in that
- the selected area of the substantially transparent film material to be embossed comprises an area that is less than the entire area of substantially transparent film material, and in that

- the step of embossing is carried out after that the interlaced image is reproduced on the information bearing layer.

The last difference regarding the sequence of operations is, in essence, the same as the one identified above between the claimed method and the method of D6.

Independently of the merits of the two first distinguishing features identified above, the claimed method appears to be inventive in view of D1 for the same reasons as those exposed above with regard to document D6.

This also applies to the claimed information bearing document of claim 8, considering that the claimed information bearing document can be distinguished from the information bearing document obtained according to D1. It is stressed, in this respect, that the interlaced image according to D1 will reflect all imperfections affecting the lens profile as to its geometry or inhomogeneity. The interlaced images (interleaved photographs) thus obtained on the information bearing layer will bear the signature of the lens profile with all its faults. This is not the case with interlaced images reproduced before incorporation of the transparent layer to the information bearing layer and the subsequent embossing of the lens profile.

5.3.3 The other cited documents are less relevant than either D1 or D6.

The subject-matter of claims 1 and 8 according to the auxiliary request is not obvious in view of the prior

art. The claimed subject-matter is thus inventive in the sense of Article 56 EPC.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the Opposition Division with the order to maintain the patent on the basis of claims 1 to 13 according to the auxiliary request filed with the statement of grounds of appeal and a description to be adapted.

The Registrar:

The Chairman:



R. Schumacher

P. Scriven

Decision electronically authenticated